

Response to Amendment

1. The reply filed on September 12, 2008 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s):

Firstly, while the response does indicate that the overall species of Figures 10-11 is elected, it does not further elect one of the sub-species *listed by the Examiner* (emphasis added).

Note that Examiner required a further election (within the overall species) of a sub-species, listing the sub-species as a sub-species “wherein the sealing processing station is a combined processing station which stamps a tear-off cover from a foil and places it over the hole” (as per claim 5, for example), or a different sub-species wherein the sealing processing station is one equipped to apply a previously stamped out tear-off cover (as per claim 6, for example). Applicant instead indicates that they “elect to pursue a sub-species covering claim 3 directed to a device configured for the production of metal covers with tear-off foils and at least one of the processing stations being a stamping processing station with an upper work tool and a lower work tool for the stamping of a hole”, which was not one of the choices for sub-species set forth by the Examiner.

Secondly, it is noted that Applicant’s arguments about which claims read on the elected overall species are unclear and not persuasive. Note that Applicant sets forth that “[A]pplicant hereby elects with traverse to pursue in this application the species of Figs. 10 and 11 as categorized by the Examiner and directed to independent claim 2”, and that “[M]oreover, the elected species also covers claims 3-9, 13-15 and 17 because these claims as amended herein each ultimately depend from elected claim 2”.

It is noted that the mere fact that a claim depends from an elected (species) claim is not an indication, in-and-of-itself, that the claims both read on the same species.

Consider the following example:

Claim 1. A writing implement comprising means for leaving a mark on a piece of paper.

Claim 2. A writing implement according to claim 1, wherein the means for leaving a mark is ink.

Claim 3. A writing implement according to claim 1, wherein the means for leaving a mark is graphite.

Claim 4. A writing implement according to claim 2, wherein the ink is red ink.

Claim 5. A writing implement according to claim 2, wherein the ink is blue ink.

Disclosed are two overall species of writing implement: a pen and a pencil. Within the species of the pen, there are disclosed two sub-species: one wherein the pen uses red ink, and one wherein the pen uses blue ink.

Claim 1 is generic to all species and sub-species. Claim 2 reads on the overall pen species and both of the sub-species re the ink color. Claim 3 reads on only the overall species of the pencil. Claim 4 reads only on the sub-species of the pen with the red ink, and claim 5 reads only on the sub-species of the pen with the blue ink.

In other words, if Applicant elects the pen as the overall species, and blue ink as the selected sub-species, claims 1, 2, and 5 read thereon. Claim 3 depends from claim 1, but that in no way affects whether or not it reads on a pen with blue ink (which it does not). Likewise, claim 4 depends from claim 2, which depends from claim 1, but again, that in no way affects whether or not claim 4 reads on a pen with blue ink (which it does not).

At this time, since Applicant has not made an election of one of the required sub-species, Examiner cannot fully assess the accuracy of Applicant's assertions regarding which claims are readable on the elected species and sub-species, but Examiner notes that based on Applicant's comments regarding claims reading on a particular species merely because of their dependency, it is suggested that Applicant closely review the claims before making a determination of which claims read on what species and sub-species.

See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. **EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).**

For Applicant's convenience, the previous election/restriction requirement is repeated hereinbelow.

Election/Restrictions

2. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

The species of Figures 10-11, the species of Figure 12, the species of Figure 13

Furthermore, there are plural sub-species within the above species, such as a species wherein the sealing processing station is a combined processing station which stamps a tear-off cover from a foil and places it over the hole (as per claim 5, for example) and a different sub-

species wherein the sealing processing station is one equipped to apply a previously stamped out tear-off cover (as per claim 6, for example)

(As a side note, Examiner notes that it does not appear that any of the species of Figures 10-11, of Figure 12, or of Figure 13 show the sealing processing station being a combined processing station which stamps a tear off cover from a foil and places it over a hole.)

Applicant is required, in reply to this action, to elect a single species (along with a single sub-species within the elected species) to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

3. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: in accordance with the guidance set forth in MPEP section 1850, it has been determined *a posteriori*, i.e., after taking the prior art into consideration, that the features common to all the claims, i.e., “an advancing mechanism and a number of processing stations arranged in succession along the advancement direction” wherein the processing stations process objects, do not constitute “special technical features” since they

do not make a "contribution" over the prior art in light of at least U.S. Pat. No. 6,098,268 to Negre et al., for example. Specifically note that Negre teaches a processing device comprising an advancing mechanism in the form of conveyor 1 that conveys an object to be processed in an advancement direction A to multiple processing stations 7, 4, 16, for example (see at least Figure 1 and col. 2, lines 51-67 and col. 3, lines 1-27, for example).

4. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erica E. Cadugan whose telephone number is (571) 272-4474. The examiner can normally be reached on Monday-Thursday, 5:30 a.m. to 4:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David P. Bryant can be reached on (571) 272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Erica E Cadugan/
Primary Examiner
Art Unit 3726

eec
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